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IN THE

Supreme Court of the United States

October Term, 1960.

No. .....

SOUTHWEST PRODUCTS CO., a corporation,

Petitioner,

vs.

AETNA STEEL PRODUCTS CORPORATION,

Respondent.

Respondent's Brief in Opposition to Petitioner's Petition for Writ of Certiorari.

Respondent hereby opposes the petition for a writ of certiorari, filed herein by Southwest Products Co., petitioner, on the primary ground that no special or important reasons exist for review by this Court.

The opinion of the Court of Appeals for the Ninth Circuit is printed in Appendix A to the petition and is reported at 282 F. 2d 323.

NO SUBSTANTIAL QUESTIONS ARE PRESENTED.

The alleged questions presented on page 2 of the petition are hypothetical, without substance and misleading. They presuppose facts and circumstances which are contrary to those stated in the opinion of the Court of Appeals.

The opinion of the Court of Appeals is in accord with applicable decisions of the Supreme Court to which reference has been had in the opinion. The opinion of the Court of Appeals is not in conflict with the decision of another Court of Appeals on the same matter, since the two Potter patents in suit have not been before any other Court of Appeals. The opinion has not decided a question of Federal law which has not been settled by prior decisions of this Court.

This Court should not waste its time on hypothetical or moot questions nor on questions based on assumed facts which are not supported by the record. The Petition for Writ of Certiorari should be denied.

STATEMENT.

This is the usual patent case where patents have been held invalid for lack of invention and on statutory grounds. Since no special questions are presented, the disgruntled patent-owner and petitioner reverts to misrepresentation and sophistry in attempting to set up questions for review.

Since the petition does not clearly, accurately and honestly present a statement of the case, respondent desires to state the case as shown by the record and the facts.

Petitioner is the owner of two patents, one relating to a ball-and-socket type of self-aligning bearing and another to a method of making it. The history of these patents is as follows.

Potter filed an application for patent in July 1945 directed to a ball-and-socket type of self-aligning bearing and a method of making it. The method claims

were canceled and withdrawn in May 1947. The claims to the bearings stood rejected by the Patent Office as of March 1950. The Court of Appeals found, after carefully examining the prior patents, many of them not cited by the Patent Office, that

> **"* * * all of the features of Potter's patent '841, so far as disclosed prior to the March 7, 1950 amendment to the application, are old in the art."** (Opinion, Appendix A to the Petition, p. 21.)*

In March, 1950 (more than five years after first public use) new claims were added to the application which introduced, for the first time, concepts which were at variance with the prior disclosure of the application. (Opinion, p. 23.) Such added claims were eventually allowed and United States Letters Patent No. 2,626,841 issued in January 1953.

In ruling that the patent lacks patentability and is invalid, the Court of Appeals referred to the statutory provision that no amendment shall introduce new matter (35 U. S. C. Sec. 132, last sentence); that what is patented must be disclosed to the Patent Office within one year of public use (35 U. S. C. Sec. 102, Sub. b) citing *Muncie Gear Co. v. Outboard Co.*, 315 U. S. 759, 768; and that any skilled artisan could produce an identical bearing by following the teachings of the prior art (referring to *Great A & P Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147; and *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545.)

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*All references to the opinion refer to pages of the opinion as it appears in Appendix A of the petition.

The method claims were solicited in an application filed by Potter in August 1947. All of these claims stood rejected as of March 1950. Again, by amendment filed in March 1950, new claims introduced new concepts but the application was rejected by the Patent Office on the ground that the amendatory matter was new matter and the application was abandoned October 1, 1951.

The Court of Appeals correctly pointed out that if Potter believed himself to be entitled to the method claims he had a right to appeal from the final rejection under the provisions of Sections 141-146 of Title 35, U. S. C. (Opinion, p. 25.) But Potter did not file such appeal and actually abandoned the application containing the method claims.

More than a year after abandoning the above application on the method, Potter filed another application in December 1952 which included the method claims and which eventually was issued as patent 2,724,172 in November 1955, more than ten years after the method had been in commercial and public use. The Court of Appeals held the method patent invalid stating:

> **"All that we have said in connection with patent '841 applies equally to patent '172. It suffers the same infirmities."** (Opinion, p. 26.)

Among the questions which had been presented to the Court of Appeals in this case were the following:

> "1. As a matter of law, did the trial court apply the correct criteria and standard of invention * * *?
>
> 2. Did the trial court commit error in failing to find that the Potter patents had been issued in

violation of statutory requirements that no new matter be added * * *?

3. Did the Court make conflicting and erroneous findings of fact?" (Opinion, pp. 5-6.)

The Court of appeals conformed to the admonitions of this Court and specifically referred to the *A & P Tea Co.* case, *supra.* In that case, the concurring opinion specifically states:

"* * * The standard of patentability is a constitutional standard; and the question of validity of a patent is a question of law. * * * The Court now recognizes what has long been apparent in our cases: that it is the 'standard of invention' that controls. That is present in every case where the validity of a patent is in issue. It is that question which the court must decide. No 'findings of fact' can be a substitute for it in any case." (Mr. Justice Douglas and Mr. Justice Black, at 340 U. S. 155 and 156.)

THE PETITION IS IN ERROR AND MISREPRESENTS THE OPINION OF THE APPELLATE COURT.

Petitioner is wrong in the stating that the Court of Appeals ignored the trial court's findings. Realizing that no "findings of fact" can be a substitute for the controlling standard of invention, the appellate court carefully examined the patents in suit, the prior art patents and the record, and found that **"* * * the patent as issued lacks patentability."** (Opinion, p. 21.)

Petitioner misrepresents the opinion of the appellate court in stating that the court did not disagree with the erroneous finding XX (appearing on pages 3-6 of the Petition). Actually the Court of Appeals found that the so called "novel concept" of using a ball as a die was not new, stating:

> **"Birchwood, Porter, Erickson, Fiegel, Hoern and Chambers, to name a few, teach the utilization of the ball element as a die member in the forming operation."** (Opinion, p. 21.)

The Appellate Court found that all of the so called "features" of the patent were old in the art and summarized by stating:

> **"Any skilled artisan in the bearing art could take Taylor's patent, add to it the concept of utilizing the ball element rather than a blank in the forming operation—a concept suggested repeatedly in the prior art—and, if the end result were a bearing frozen in tight engagement, liberate it as taught by Heim, Hoern and others, and he would produce a bearing in all respects identical with that of plaintiff."** (Opinion, p. 22.)

Thus the Appellate Court found that the Potter patents in suit did not conform to the standard of patentability required by Sec. 103, Title 35, U. S. C. No new result was obtained by the use of the old elements in the old combinaton by the use of old steps.

NO SUBSTANTIAL QUESTIONS ARE PRESENTED AND THERE ARE NO REASONS FOR REVIEW.

The petition should be denied because petitioner presents speculative, hypothetical and illusory academic questions which presuppose facts and conditions that do not exist in this case. Academic questions should not take up the time of this Court. This Court should not be asked to unwittingly formulate criteria (in response to hypothetical and loaded questions) by which future issues within a larger area of existing patent legislation may be erroneously prejudged. (See concurring Opinion of Mr. Justice Frankfurter in *Funk Bros. Seed Co. v. Kalo Co.*, 333 U. S. 127, at p. 135.)

1. Petitioner resorts to distortion and misrepresentation in attempting to generate confusion. Petitioner's question 1 confuses patentability, invention and validity. There is no confusion in the Court of Appeals as to the necessity of applying the constitutional standard of invention. The appellate court is fully aware that the factual background of each case must be taken into consideration in applying a rule of law. Circuit Judge Pope of the Court of Appeals, Ninth Circuit, made a study of the decisions and was satisfied that there was no real conflict. Judge Pope, in his concurring opinion in *Bergman v. Aluminum Lock Shingle Corp. of America*, 251 F. 2d 801, at pages 809 to 813, resolves any alleged conflict in the decisions of the Court of Appeals for the Ninth Circuit. He cogently points out that whether the device, process or what is now claimed to be an invention existed before or was known in the prior art, or was not, may be a question of fact; that whether what is now claimed as an advance is to be

called an invention over the prior art, or is not, is a question of law to be determined by the Constitutional standard of invention as interpreted by the *A. & P Tea Co.* case; and that the Ninth Circuit decisions are consistent in light of these considerations. Respondent adopts the concurring opinion of Judge Pope in *Bergman v. Aluminium Lock Shingle Corp. of America, supra* (reprinted in full in Appendix I), as a complete refutation of petitioner's false premise. The danger of hypothetical questions, such as presented here by petitioner is made evident from a reading of Judge Pope's scholarly presentation.

2. Petitioner's second question is based upon an erroneous interpretation as to what the Ninth Circuit has held. At pages 10 and 11 of the petition, the petitioner incorrectly states:

> "In the instant case the court has held that the amendment that was made in the application leading to patent No. 2,626,841 was unauthorized and added to the claim an invention not previously presented to the Patent Office and the claim was therefore invalid because devices embodying the invention had been on sale more than a year prior to the presenting of this amendment.
>
> "* * * Obviously the stress pattern was inherent in the original disclosure and this fact is expressed in Findings which were set aside by the Court below without any reasons whatsoever. Therefore, the Court of Appeals for the Ninth Circuit has in effect held that it is not permissible to amend a claim more than one year after public use to limit the already claimed elements to characteristics inherent in the original disclosure."

On the contrary, the Circuit Court recognized that *as a matter of law*, the patent had to be held invalid, stating:

> "If, as claimed by appellee, the alleged new matter is readable upon the specifications, drawings and claims as first filed, it must be held that the same would also be readable upon the prior patents in the art, including those which caused the Patent Office to reject the earlier claims, **and if this be the case there is nothing patentable.** It is clearly the law that a patent should not be granted for discovery of a result that would flow naturally from the teachings of the prior art.
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> * * * * * * *
>
> "As as have just indicated, the stress and strain matter added by the March 7, 1950 amendment is either new to the application—hence unpatentable —or no more than a scientific explanation of what takes place in the manufacture of Potter's originally described article as well as other bearings patented in the art. A scientific explanation cannot be patented in any event, whether originally disclosed in an application or by way of amendment. DeForest Radio Co. v. General Electric Co., 283 U. S. 664." (Opinion, pp. 24-26.)

There is no conflict as to the rules stated in *Muncie Gear Co. v. Outboard Co.*, 315 U. S. 759 and *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U. S. 211. The applicability of the rule depends upon the facts and circumstances in each case. A perversion of the facts of the instant case does not create a reviewable question.

Petitioner's second question is also loaded in that it is based upon the false premise that an *invention* was disclosed in the original application filed by Potter. Here the Court of Appeals found that **there was no invention.** As stated by that court, the new concepts introduced five years after prior public use were either new to the application and therefore unpatentable, or no more than a scientific explanation of what takes place in Potter's bearing and also in other bearings previously patented in the art.

3. There is no basis for petitioner's question three: it is purely academic. There is only one standard of invention and it is equally applicable to mechanical and process combination claims alike.

The case of *Expanded Metal Co. v. Bradford*, 214 U. S. 366, decided that a process patent was contemplated within the term "art" as then used in the Statute, and recognized that the rule of *Loom Company v. Higgins*, 105 U. S. 580, as to patentability of combination claims, was applicable to process as well as to mechanical combination claims. The rule was stated as follows:

> "It is perfectly well settled that a new combination of elements, old in themselves, but which produce a new and useful result, entitles the inventor to the protection of a patent. *Loom Company v. Higgins*, 105 U. S. 580-591."
>
> *Expanded Metal Co. v. Bradford, supra*, at page 381.

This well established rule has been restated by this Court in the *A & P Tea Co.* case wherein it was also recog-

nized that there must be a new and useful result, this Court stating:

> "The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable."
>
> *Great Atlantic and Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, 152.

The petitioner's question three is not only moot and academic, but is further improper in that it presupposes a case where two new steps are combined with the old to produce a new result. In the instant case, the two supposedly new steps of **forming** a race ring around a ball and then **striking** or applying pressure to the ring to cause liberation of the ball (when needed) were **both old.** The Court of Appeals found these steps to be old. With respect to the old Taylor patent the court commented that:

> **"* * *, the forming operation is essentially identical with the operation taught by Potter."** (Opinion, p. 21.)

The patents to Paulus, Heim and Hoern all recognized the need for liberation and all taught a solution to that problem by striking or applying force to the outer race ring. (Opinion p. 21.)

> **"There was, moreover, much testimony in the trial that freeing bearings by hammering on the race is very old in the art."** (Opinion, p. 17.)

There is only one standard of invention and it applies to combination patents on machines and to combination patents where steps are combined. When the court

finds that the procedural steps in a process are identical in all respects with those followed in prior patents, the process or method claims are held invalid as in *Graver Mfg. Co. v. Linde Co.*, 336 U. S. 271 at page 278. This is particularly true when the end result, that is the bearing, is not a new bearing and no new result has been produced. In the instant case the court found that the old patent to Fiegel disclosed a ball and socket joint **"remarkably similar to the self-aligning bearings involved here."** (Opinion, p. 19.)

4. Petitioner's question four is based upon the false assumption that the appellate court came to its conclusion of lack of patentability solely by reference to the file history. This is not so. The appellate court devoted pages 15 to 22 of its opinion (as reprinted in Appendix A of the Petition) to a careful examination of prior art patents, many of which were not considered by the Patent Office, stating:

> "We note the foregoing patents in the bearing art for the purpose of demonstrating the appropriateness of the action of the Patent Office in rejecting Claims 1, 2, 5 and 6 of the article application, **as well as for the proposition that the patent as issued lacks patentability."** (Emphasis added; Opinion, p. 21.)
>
> **"Any skilled artisan** in the bearing art could take Taylor's patent, add to it the concept of utilizing the ball element rather than a blank in the forming operation—a concept suggested repeatedly in the prior art—and, if the end result were a

bearing frozen in tight engagement, liberate it as taught by Heim, Hoern and others, and he **would produce a bearing in all respects identical with that of plaintiff."** (Opinion, p. 22.)

Clearly, the subject matter as a whole, in the light of prior knowledge in the art and pursuant to Section 103, Title 35, U. S. C., was considered by the appellate court in holding the patents invalid. There is, therefore, no basis for this Court reviewing the hypothetical question presented here by Petitioner's question four.

CONCLUSION.

It is submitted that the petition for writ of certiorari should be denied because no special or important questions are presented, there are no compelling reasons for review, and the alleged questions presented are hypothetical, academic and based on misstatements and suppositions. The inaccuracies and misstatements of the petition justify denying the petition pursuant to the Revised Rules of the Supreme Court of the United States, Rule 23, Subdivision 4, 28 U. S. C. A.

Respectfully submitted,

C. A. MIKETTA,

Attorney for Respondent.

APPENDIX I.

Bergman v. Aluminum Lock Shingle Corp. of America, 251 F. 2d 801, [809-813] (C. A. 9, 1957).

Pope, Circuit Judge, concurring.

I think that Judge **Lemmon's** opinion performs a particularly useful service in doing away with a frequent misapprehension that the question of the validity of a claim of a patent is solely one of fact. In this case there was no patentable invention for the simple reason that it comes precisely within the language of Lincoln Engineering Co. of Illinois v. Stewart-Warner Corp., 303 U. S. 545, 549, 58 S. Ct. 662, 664, 82 L. Ed. 1008: "The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention." The quoted statement is a rule of law. It sets a legal standard or test of invention. For failure to meet this legal standard appellee must fail. Thus we determine that there is no invention here as a matter of law.

This is not to say that the decision in a patent case may not turn upon a question of fact; as for instance where the court must determine whether the mechanical device or the process now claimed to be invention was something that existed or was known or used in the past. But it is necessary in reading the opinions dealing with the question of validity of patents to bear this distinction in mind, otherwise considerable confusion may result. Thus in Stauffer v. Slenderella Systems of California, Inc., ... F. 2d ....., ... (decided Nov.

15, 1957) we said: "This court has consistently held that the question of validity of a claim of a patent is one of fact."[1] On the other hand, in Kwikset Locks v. Hillgren, 9 Cir., 210 F. 2d 483, 488, this court rejected the argument made by the patentee whose claim of invention had been sustained by the findings of the district court, that "A finding of validity is a finding of fact which cannot be reversed unless clearly erroneous", and said: "However, we must also recognize 'that it is the "standard of invention" that controls. That is present in every case where the validity of a patent is in issue. It is that question which the court must decide. No "finding of fact" can be a substitute for it in any case.' "[2] In like manner in Oriental Foods v. Chun King Sales, 9 Cir., 244 F. 2d 909, 913, this court, again holding invalid for want of invention a claim of patent which the trial court had held represented invention over the prior art, followed Kwikset Locks v. Hillgren, *supra*, and said: "The standard of invention is written into the Constitution. The Supreme Court has held that the determination by the trial court of the question of invention need not be accorded the respect given ordinary findings of fact."[3]

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[1]The Court added a footnote citing other decisions of this court in which similar language had been used.

[2]This quoted language is that of Mr. Justice Douglas, concurring, in Great A. & P. Tea Co. v. Supermarket Equipment Corp., 340 U. S. at p. 156, 71 S. Ct. at p. 132.

[3]The court at the same time alluded to the recent case of Hall v. Wright, 9 Cir., 240 F. 2d 787, 790 in which we had said that "The question of novelty and invention of a patented device or method is a question of fact," and expressly declined to modify that statement.

"I have no doubt that an uncritical reading of these various statements found in our decisions might give rise to some confusion.[4] If I thought that our holding in the present case that the question of the validity of this patent is one of law represented a true conflict with prior holdings of this court, I would think it important that we should call for a hearing by the whole court sitting *en banc* in order to resolve that conflict. But I am satisfied from a study of our prior decisions that the conflict is more apparent than real.

Prior to the decision of the Supreme Court in Great A. & P. Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147, 71 S. Ct. 127, this court stated and seems to have held in an extended line of decisions that the question of invention presented a question of fact. A case much cited was Ralph N. Brodie Co. v. Hydraulic Press Mfg. Co., 151 F. 2d 91, 94, where in referring to the appellant's contention that the combinations did not involve invention and that therefore the claims were invalid, we said: "The question thus presented was one of fact." In so holding we relied upon Thomson Spot Welder Co. v. Ford Motor Co., 265 U. S. 445, 446, 44 S. Ct. 533, 534, 68 L. Ed. 1098, where the Court said: "The question whether an improvement requires mere mechanical skill or the exercise of the faculty of invention, is one of fact; and in an action at law for infringement is to be left to the determination of the jury." Other earlier decisions of this court expressing similar views are Maulsby v. Conzevoy, 161 F. 2d 165, 167; Refrigeration Engineering v. York Corp., 168 F.

[4]For a suggestion that there may have been confusion elsewhere see Noble Co. v. C. S. Johnson Company, 7 Cir., 241 F. 2d 469, footnote at page 477.

2d 896; Faulkner v. Gibbs, 170 F. 2d 34; and Lane-Wells Co. v. M. O. Johnson Oil Field Serv. Corp., 181 F. 2d 707. However, on December 4, 1950, the Supreme Court handed down its decision in Great A. & P. Tea Co. v. Supermarket Equipment Corp., *supra*, involving a combination patent. It noted that "The Court of Appeals regarded this finding of invention as one of fact, sustained by substantial evidence, and affirmed it as not clearly erroneous." It spoke of the inadequacy of its earlier decisions in defining the indicia of invention a court should require, referring to the "imprecision of our language" and said that the Court "* * * never has ventured to give a precise and comprehensive definition of the test to be applied in such cases." The Court then restated the standard applied in Lincoln Engineering Co. v. Stewart-Warner Corp., quoted *supra*, and rejected the argument that since two courts had made findings of fact in favor of the alleged invention the Supreme Court should not undertake to review them. It said (340 U. S. at p. 153, 71 S. Ct. at p. 131): "The questions of general importance considered here are not contingent upon resolving conflicting testimony, for the facts are little in dispute. We set aside no finding of fact as to invention, for none has been made except as to the extension of the counter, which *cannot stand as a matter of law.*"[5] (Emphasis added.)

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[5]This statement from the opinion of Mr. Justice Jackson, who spoke for the majority of the Court, is plainly in full agreement with that made in the concurring opinion of Mr. Justice Douglas (340 U. S. at p. 156, 71 S. Ct. at p. 132), as follows: "The Court now recognizes what has long been apparent in our cases: that it is the 'standard of invention' that controls. That is present in every case where the validity of a patent is in issue. It is

The courts of appeals began to recognize that in the Great A. & P. Tea Co. decision the Supreme Court had now more precisely defined the nature of the judicial process by which the question of invention is to be determined and from that time on this court has generally adhered to the rule which Judge Lemmon has so well stated for us in this decision.

The first real test of where this court stood following the Great A. & P. Tea Co. case in Himes v. Chadwick, 9 Cir., 199 F. 2d 100. In that case a jury returned a verdict finding the claims in issue to be valid and infringed. Upon a motion for judgment notwithstanding the verdict, the court (Judge Lemmon presiding), granted the motion and entered judgment holding the claims in issue to be invalid. On appeal it was argued that the question of the presence or absence of patentable invention was a question of fact within the province of the jury to determine and the right of the court to determine invalidity of the patents notwithstanding the jury's verdict was challenged. In dealing with the question of the right and duty of the trial judge to direct a verdict in a patent case, where the circumstances indicated that the jury had departed from the relevant legal criteria for determining patentability, this court cited and relied upon the Third Circuit's decision in Packwood v. Briggs & Stratton Corp., 195

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that question which the Court must decide. No 'finding of fact' can be a substitute for it in any case. The question of invention goes back to the constitutional standard in every case. We speak with final authority on that constitutional issue as we do on many others." That the Court itself recognized that both Mr. Justice Douglas and Mr. Justice Jackson were in agreement upon this point is apparent from the allusion to that case in the footnote to Dalehite v. United States, 346 U. S. 15, at p. 24, 73 S. Ct. 956, 97 L. Ed. 1427.

F. 2d 971, 973, a case which duly noted the significance of Great A. & P. Tea Co.[6] We gave emphatic approval to the discussion by that court of the proposition that over the years the Supreme Court has developed and laid down rules and standards for use as guides in the determination of what is invention within the meaning of the Constitution and the patent laws. Using the language of the Packwood case: "Once such standards and rules are authoritatively announced any finding of 'invention' whether by a court or a jury must be consistent with them", this court proceeded to sustain the judgment of invalidity notwithstanding the verdict of validity. The claims involved did not measure up to established legal standards for invention.

This case was followed by our decision in Kwikset Locks v. Hillgren, *supra*. Thereafter, in Coleman Co. v. Holly Manufacturing Co., 233 F. 2d 71, notwithstanding the trial court in upholding the validity of the patent there involved, had made elaborate findings of fact, Judge Bone, speaking for this court, examined the findings and the evidence at great length in the light of the teachings of Great A. & P. Tea Co., and after carefully testing the devices there involved against the legal standards for determination of invention and patentability laid down in that case, concluded that the device measured up to those standards and accordingly upheld the validity of the patent. I have noted Judge Barnes' statement in Oriental Foods v. Chun King Sales, *supra*, that "The standard of invention is written in the Constitution." In so stating he relied spe-

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[6]The Packwood case has been often followed in its own circuit. See, *e.g.*, Nachtman v. Jones & Laughlin Steel Corp., 235 F. 2d 211.

cifically on both the majority and the concurring opinions in the Great A. & P. Tea Co. case.

This fairly extended line of decisions in this court since the Great A. & P. Tea Co. decision demonstrates, I think, that we are here approving the accepted doctrine that the question of invention must be tested by an application of the established legal standards referred to in the Packwood case, *supra*. This does not mean of course that the question of the validity of a claimed invention may *not turn* on a question of fact. In this respect a patent case is no different from any other kind. Generally speaking some cases will turn on a question of law and other cases will turn on a question of fact. To my mind a case well illustrating this is Graver Tank & Mfg. Co. v. Linde Air Products Co., 336 U. S. 271, 69 S. C. T. 535, 93 L. Ed. 672. One question before the Court was whether there was invention, this depended upon what was the state of the prior art in the field of electric welding. At the trial many witnesses were called, some of them experts, and many demonstrations were made to permit the Court to learn the stage the prior art had reached. It was claimed that the results produced by the processes involved in the invention were quite different than those possible under all prior methods in the prior art. Not only did the judge hear and see witnesses whose credibility and qualifications he might judge, but he visited laboratories and observed demonstrations of the welding taught by the patent and as done under various stages of the prior art. The judge found that there was a remarkable difference between what could be done under the invention and what had gone on before. The Supreme Court declined to reverse the de-

cision upholding these claims of the patent. Plainly enough that was a case in which the validity of the invention "turned upon" a question of fact.[7]

It is my view that a study of this court's decisions since the Great A. & P. Tea Co. case, *supra,* which have stated that the question of invention is one of fact, will demonstrate either that such statement in that unqualified form was unnecessary to the decision, or else that the court was saying in substance that under the particular facts of the case the decision "turned upon" questions of fact. Thus in Leishman v. General Motors Corp., 9 Cir. 191 F. 2d 522, this court upheld the trial court's finding that certain characteristics of the patented device were anticipated by an earlier patent, and that the earlier patent had functions and modes of operation which were identical with those of the patented device. This finding was based upon oral testimony of engineers describing and explaining the engineering principles involved and that they were long known to machine designers as a means of accomplishing the same object.

We said (at p. 529): "We think therefore that this particular finding must be held to be the result of a determination of a question of fact, which cannot be said to be clearly erroneous, and that Rule 52(a) Federal Rules of Civil Procedure, 28 U. S. C. A., prohibits

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[7]In his concurring opinion in the Great A. & P. Tea Co. case, Mr. Justice Douglas suggests that that case overruled the Graver case. I find no such statement in the majority opinion; that may be because the majority considered Graver could be distinguished as here suggested.

us from disturbing it." In this we relied upon the decision of the Supreme Court in Graver Tank & Mfg. Co. v. Linde Air Products Co., *supra*, concluding. "* * * where as here, the decision *turned upon questions of fact*, and Appellate Court is not in a position to try such fact questions *de novo*." (Emphasis added.)

In the Leishman case, as in the Graver case, the question of invention involved mixed questions of fact and law. The legal standard was a most simple one, namely, that to have invention there must be something new. In each of those cases the legal standard was not satisfied if the prior art had produced the same thing that was claimed in the invention. In Graver the court found that the prior art did not include the principle claimed. In Leishman, the trial court found that the prior art did include it. In each case the decision "turned upon" a question of fact; but in neither case could it properly be said without qualification that the question of validity of a claim of a patent is one of fact.

Our cases decided since Great A. & P. Tea Co., are not inconsistent with what I think it well stated in Deller's Walker on Patents, 1957 Supp., to page 115 of Volume 1 of the original text, as follows: "The conflict between the statement that the question of invention is one of fact and the almost innumerable instances in which the courts have dealt with it as though it were one of law, can only be explained by breaking

the question of patentable invention down into its component parts: what the prior art was and what the patentee did to improve upon it, and then, whether what the patentee did is properly to be classified as an invention. The nature of the prior art and the nature of what the Patentee did to improve upon it must always be questions of fact. The question of the name to be given to what was done by the Patentee, whether it is to be called an invention over the prior art or whether it is not, is a question fundamentally of the meaning of the words used in the statute [35 U. S. C. §31], and as such would seem to be a question of law."